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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,897	12/09/2003	Andrew M.K. Pennell	019934-003720US	6930
20350 7590 11/06/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER BERNHARDT, EMILY B				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
11/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/732,897

**Applicant(s)**

PENNEL ET AL.

**Examiner**

EMILY BERNHARDT

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/30/08 (RCE Request).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 6, 7, 10, 11, 18-21, 23-27, 30-35, 37-47 and 53 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1, 4, 6, 7, 10, 11, 18-21, 23-27, 30-35, 37-47 and 53 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 6/30/08 has been entered.

The request to correct the inventorship of this nonprovisional application under 37 CFR 1.48(a) is deficient because:

An oath or declaration by **each actual inventor or inventors** listing the entire inventive entity has not been submitted.

The only Declaration submitted and signed is by the newly added inventor.

Additionally, since one of the inventors (Mcmaster) is deceased, see MPEP 201.03 for procedure to follow regarding the reexecution of a Declaration/oath. See section entitled "Declaration or Oath", which in part is reproduced below.

**Petitions under 37 CFR 1.47 are only applicable to an original oath or declaration and are not applicable to the reexecution of another oath or declaration by A. In such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement of 37 CFR 1.64 that each of the actual inventors, i.e., inventor A, execute the oath or declaration, particularly where assignee consent is given to the requested correction.**

Due to the request for inventorship change commonly assigned WO'853 is a competent reference for the reasons set forth below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4,6-7,10-11,18-21,23-27,30-35,37-43,46-47 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by Pennell (WO'853). The commonly assigned publication has an international filing date that precedes applicants' instant filing date and a different inventive entity based on the 1.48(a) request submitted by applicants. It describes many compounds within the instant scope for the same uses beginning with page 102 through 164. Species include trisubstituted pyrazoles as can be seen for example on p.107.

It is recognized applicants are urging benefit under 35 USC 120 of earlier parent, now US 7,157,464 and earlier provisional case under 35 USC 119(e). However benefit is not granted as subject matter claimed herein is not entirely described in parent much less in provisional application which is a much narrower disclosure. Compare scope of Ar<sup>1</sup> substituents with that described in parent as well as scope of HAr substituents which is broader in the instant claims. For example for Ar<sup>1</sup> substituents, O-X<sup>2</sup>OR<sup>c</sup>, O-X<sup>2</sup>NR<sup>c</sup>R<sup>d</sup> is not seen in parent disclosure or "NR<sup>c</sup>R<sup>dn</sup>"-containing moieties where the NR<sup>c</sup>R<sup>d</sup> form

rings. For HAr substituents, at the very least  $X^3Y$ , is not seen in parent disclosure or "NR<sup>f</sup>R<sup>g</sup>": containing moieties where the NR<sup>f</sup>R<sup>g</sup> form rings. Thus only the instant filing date is accorded the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell (WO'853). Said claims have certain requirements on the phenyl and pyrazole rings which is not seen to be anticipated by the species in Pennell. However

Species 1.028 on p.149 is very close structurally as the only difference is in the nature of R<sup>3c</sup> i.e. methyl in the prior art species vs. amino, trifluoromethyl, methythio or "Y" permitted herein. However, Pennell teaches the interchangeability of all these groups as can be seen in the preferred embodiments described in sections [0056] and [0057] for subgeneric formulas. Thus it would have been obvious to one skilled in the art at the time the instant invention was made to modify the species pointed out in Pennell with other moieties such as those recited in claims 44 and 45 and in so doing obtain additional compounds for use as CCR1 antagonists.

Pennell is competent for reasons given in the above 102 rejection.

In response to this office action applicants are requested to provide an updated set of claims to reflect the Examiner's Amendment and any other amendments applicants may make to the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily Bernhardt/

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Primary Examiner, Art Unit  
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